

Remarks/Arguments:

Applicants filed this continuation application to pursue claims directed to a modular prosthesis. Claims 54-60, now pending in this application, were substantially copied from U.S. Patent No. 6,416,542, which issued to Marcade et al.

Applicants present this Supplemental Preliminary Amendment in conjunction with a Request by Applicants for Interference Pursuant to 37 C.F.R. § 1.607 wherein Applicants respectfully request that an interference be declared between the above-identified application and U.S. Patent No. 6,416,542. The information required by 37 C.F.R. § 1.607(a) is set forth below, under headings which correspond to the subsections of § 1.607(a) to facilitate consideration by the Examiner.

I. IDENTIFICATION OF THE PATENT WHICH INCLUDES SUBJECT MATTER WHICH INTERFERES WITH THE APPLICATION (37 C.F.R. § 1.607(a)(1))

The patent which claims subject matter which interferes with subject matter claimed in the present application ("the Goicoechea application") is U.S. Patent No. 6,416,542 ("the Marcade patent"), which issued on July 9, 2002 to Marcade et al. for "MODULAR BIFURCATED INTRALUMINAL GRAFTS AND METHODS FOR DELIVERING AND ASSEMBLING SAME." The Marcade patent was issued from Application Serial No. 09/365,683 ("the Marcade application"), filed August 3, 1999. Endovascular Technologies, Inc. is the assignee named on the face of the Marcade patent. A copy of the Marcade patent is enclosed for the Examiner's convenience.

II. PRESENTATION OF PROPOSED COUNTS (37 C.F.R. § 1.607(a)(2))

Attached Appendix A sets forth two proposed counts. Proposed Count I is at least as broad as claim 1 of the Marcade patent. Proposed Count II is at least as broad as claim 16 of the Marcade patent. Claim 54 of the Goicoechea application corresponds exactly to Proposed Count I. Claim 58 of the Goicoechea application corresponds exactly to Proposed Count II.

III. IDENTIFICATION OF AT LEAST ONE CLAIM OF THE MARCADE PATENT WHICH CORRESPONDS TO THE PROPOSED COUNT (37 C.F.R. § 1.607(a)(3))

Claims 1-15 of the Marcade patent correspond to Proposed Count I. In order to assist the Examiner, attached Appendix B sets forth a side-by-side comparison of claim 1 of the Marcade patent with Proposed Count I.

Claims 16-20 of the Marcade patent correspond to Proposed Count II. In order to assist the Examiner, attached Appendix C sets forth a side-by-side comparison of claim 16 of the Marcade patent with Proposed Count II.

IV. CLAIMS OF THE GOICOECHEA APPLICATION WHICH CORRESPOND TO THE PROPOSED COUNT (37 C.F.R. § 1.607(a)(4))

Claims 54-57 of the Goicoechea application correspond to Proposed Count I. Claim 54 of the Goicoechea application is identical to Proposed Count I. Claims 55-57 of the Goicoechea application are directed to the same patentable invention as Proposed Count I.

Claims 58-60 of the Goicoechea application correspond to Proposed Count II. Claim 58 of the Goicoechea application is identical to Proposed Count II. Claims 59 and 60 of the Goicoechea application are directed to the same patentable invention as Proposed Count II.

V. APPLICATION OF TERMS OF THE CLAIMS TO THE DISCLOSURE OF THE APPLICATION (37 C.F.R. § 1.607(a)(5))

To assist the Examiner, Applicants attach Appendix D. Appendix D is a chart providing an element-by-element recitation of the claims of the Goicoechea application identified in Section IV as corresponding to Proposed Counts I and II and an indication of the passages in the Goicoechea application where, at the very least, the claims find support.

2002, the date on which the Marcade patent was granted. Accordingly, the requirements of 35 U.S.C. § 135(b) are satisfied.

VII. PRIOR ART TO CLAIMS OF THE MARCADE PATENT

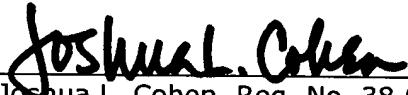
U.S. Patent No. 5,609,627, which issued March 11, 1997 as a result of Application No. 08/317,763 filed by Goicoechea et al. on October 4, 1994, qualifies as prior art to the Marcade claims under 35. U.S.C. § 102(e) because it was filed before February 24, 1995, the earliest effective filing date that can be alleged by Marcade. A copy of the U.S. Patent No. 5,609,627 is enclosed for the Examiner's convenience.

U.S. Patent No. 5,609,627 anticipates or renders obvious each of claims 1-20 of the Marcade patent. U.S. Patent No. 5,609,627 does not qualify as prior art to the present Goicoechea application, which has an effective filing date at least as early as September 27, 1994 as set forth above.

CONCLUSION

Applicants respectfully request that an interference be declared employing Proposed Count I, as set forth on attached Appendix A, with claims 1-15 of the Marcade patent and claims 54-57 of the Goicoechea application designated as corresponding thereto. Applicants further respectfully request that the interference be declared also employing Proposed Count II, as set forth on attached Appendix A, with claims 16-20 of the Marcade patent and claims 58-60 of the Goicoechea application designated as corresponding thereto.

Respectfully submitted,



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Attorney for Applicants

JLC/lk/pb

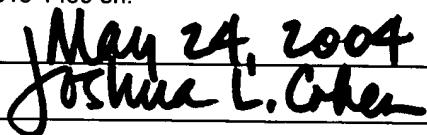
Attachments: U.S. Patent No. 6,416,542 to Marcade et al.
U.S. Patent No. 5,609,627 to Goicoechea et al.
Copy of BPAI Decision dated July 27, 2001
Copy of European Applications EP 94400284.9 and EP 94401306.9

Dated: May 24, 2004

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May 24, 2004
Joshua L. Cohen

APPENDIX A

PROPOSED COUNT I

A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:

a prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and extending longitudinally between a proximal end and a distal end, said prosthesis portion having a single inlet at said proximal end;

a proximal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end, said proximal prosthesis portion being formed separately from said prosthesis portion and being adapted to lie in the aorta with said proximal end pointing toward the heart and sized to fit a diameter of the aorta;

each of said prosthesis portion and said proximal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and

joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

PROPOSED COUNT II

A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:

a prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end;

a proximal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said proximal prosthesis portion being formed separately from said prosthesis portion and being adapted to lie in the aorta with said proximal end pointing toward the heart and sized to fit a diameter of the aorta;

each of said prosthesis portion and said proximal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;

at least one distal prosthesis portion expandable radially between a collapsed configuration and an expanded configuration and having a proximal end and a distal end, said distal prosthesis portion including a flexible layer and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and

connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.

APPENDIX B

MARCADE CLAIM 1	PROPOSED COUNT I
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a base member	a prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
extending longitudinally between a proximal end and a distal end,	extending longitudinally between a proximal end and a distal end,
said base member having a single inlet at said proximal end;	said prosthesis portion having a single inlet at said proximal end;
a primary tubular limb	a proximal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said primary limb having a single inlet at said proximal end and a single outlet at said distal end,	said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,
said primary limb being formed separately from said base member and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said base member and said primary limb including	each of said prosthesis portion and said proximal prosthesis portion including
a flexible layer and	a flexible layer and

an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
joining means for intraluminally joining said distal end of said primary limb to said proximal end of said base member.	joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.

APPENDIX C

MARCADE CLAIM 16	PROPOSED COUNT II
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:
a base member	a prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end;	having a proximal end and a distal end;
a primary tubular limb	a proximal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said primary limb being formed separately from said base member and	said proximal prosthesis portion being formed separately from said prosthesis portion and
being adapted to lie in the aorta with said proximal end pointing toward the heart and	being adapted to lie in the aorta with said proximal end pointing toward the heart and
sized to fit a diameter of the aorta;	sized to fit a diameter of the aorta;
each of said base member and said primary limb including	each of said prosthesis portion and said proximal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	an expandable stent radially supporting said flexible layer along substantially the entire length thereof;

at least one secondary tubular limb	at least one distal prosthesis portion
foldable radially between a collapsed configuration and an expanded configuration and	expandable radially between a collapsed configuration and an expanded configuration and
having a proximal end and a distal end,	having a proximal end and a distal end,
said secondary tubular limb including	said distal prosthesis portion including
a flexible layer and	a flexible layer and
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and
connecting means for connecting said proximal end of said secondary limb to said distal end of said base member.	connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.

APPENDIX D**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF THE GOICOECHEA APPLICATION**

Application claim	Disclosure of Goicoechea Application
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 29, lines 5-21; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 29, line 22 to page 30 line 7
extending longitudinally between a proximal end and a distal end,	page 29, lines 5-13; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4; Figs. 14-20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 29, lines 10-14; page 32, lines 16-17; page 27, lines 3-8; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 29, lines 8-18; Fig. 1B; page 32, lines 16-17; page 27, lines 19-25; Fig. 1A
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 26 to page 5, line 13
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 26 to page 5, line 13
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 30, line 23 to page 31, line 4
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 27, lines 14-18
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7

a prosthesis portion	page 25, lines 22 to page 26, line 8; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end;	Figs. 1A, 6, 14-20
a proximal prosthesis portion	Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 27, lines 19-27
having a proximal end and a distal end,	Figs. 1A, 6, 14-20
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 22, lines 17-22; page 23, line 11 to page 26, line 8
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 28, line 13 to page 29, line 4; Figs. 14-20
sized to fit a diameter of the aorta;	page 28, line 13 to page 29, line 4
each of said prosthesis portion and said proximal prosthesis portion including	
A flexible layer	page 27, lines 3-8; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 27, lines 19-25; Figs. 5-7
at least one distal prosthesis portion	page 29, line 19 to page 30, line 7; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration and	page 27, lines 19-27; page 29, line 22 to page 30, line 7
having a proximal end and a distal end,	Figs. 1A, 1B, 6, 14-20
said distal prosthesis portion including	

a flexible layer and	page 27, lines 3-13; page 29, lines 10-14; Fig. 6
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1A, 1B, 6, 14-20
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 4, line 26 to page 5, line 13; page 26, line 25 to page 27, line 2; Figs. 1A, 1B, 6; page 29, line 22 to page 30, line 7
Claim 59	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 29, line 22 to page 30, line 7
Claim 60	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 26, lines 19-25; page 29, lines 16-17

APPENDIX E**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF U.S.**
APPLICATION NO. 08/312,881

Application claim	Disclosure of Application No. 08/312,881
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 24, line 22 to page 25, line 14; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 25, line 16 to page 26, line 1
extending longitudinally between a proximal end and a distal end,	page 24, line 22 to page 25, line 4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 8-13; page 19, line 3 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 11
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 11

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer	page 24, line 27 to page 25, line 4; page 22, lines 19-23; Figs. 5-7
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 25, line 16 to page 26, line 1; page 23, lines 9-15; Figs. 5-7
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 7 to page 5, line 10
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 7 to page 5, line 10
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 26, lines 16-25
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 23, lines 3-7
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 21, lines 4-18; Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17

having a proximal end and a distal end;	Figs. 1A, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 8-13; page 19, line 6 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 11
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 11
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 22, lines 19-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 23, lines 9-15; Figs. 5-7
at least one distal prosthesis portion	page 22, lines 4 to 16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17; page 25, line 16 to page 26, line 1.
having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer	page 22, line 18 to page 23, line 1; page 24, line 27 to page 25, line 4; Fig. 6

and an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1B and 6
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 9-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6; page 4, line 7 to page 5, line 10
Claim 59	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 25, line 16 to page 26, line 1; page 4, line 7 to page 5, line 10
Claim 60	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 22, lines 8-9

APPENDIX F**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF EP APPLICATION NO. 94401306.9**

Application claim	Disclosure of EP Application No. 94401306.9
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 24, line 22 to page 25, line 4; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 25, line 16 to page 26, line 1
extending longitudinally between a proximal end and a distal end,	page 24, line 22 to page 25, line 4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6, 7
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 7-13; page 19, line 3 to page 21, line 18
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 20
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 20

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 24, line 27 to page 25, line 4; page 22, lines 18-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 25, line 16 to page 26, line 1; page 23, lines 9-17; Figs. 5-7
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 7 to page 5, line 12
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 7 to page 5, line 12
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 26, lines 16-25
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 23, lines 3-7
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5-7
a prosthesis portion	page 21, lines 4-18; Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration and	page 23, lines 9-17

having a proximal end and a distal end;	Figs. 1A, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 23, lines 9-17
having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 18, lines 7-13; page 19, line 3 to page 24, line 20
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 23, line 27 to page 24, line 20
sized to fit a diameter of the aorta;	page 23, line 27 to page 24, line 20
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 22, lines 18-23; Figs. 5-7
an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 23, lines 9-15; Figs. 5-7
at least one distal prosthesis portion	page 22, lines 4-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expandable configuration	page 23, lines 9-17; page 25, line 16 to page 26, line 1
and having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer and	page 22, line 18 to page 23, line 1; page 24, line 27 to page 25, line 4; Fig. 6

an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Figs. 1B and 6
connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 9-16; page 25, line 16 to page 26, line 1; Figs. 1A, 1B, 6; page 4, line 7 to page 5, line 12
Claim 59	
wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 25, line 16 to page 26, line 1; page 4, line 7 to page 5, line 12
Claim 60	
wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 22, lines 8-9

APPENDIX G**APPLICATION OF THE GOICOECHEA CLAIMS TO THE DISCLOSURE OF
EPO APPLICATION NO. 94400284.9**

Application claim	Disclosure of EPO Application No. 94400284.9
Claim 54	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5, 6
a prosthesis portion	page 21, lines 10-24; Figs. 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 22, line 1-13
extending longitudinally between a proximal end and a distal end,	page 21, lines 10-14; page 23, lines 1-4; Figs. 1B, 6
said prosthesis portion having a single inlet at said proximal end;	Figs. 1B, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration	page 20, lines 4-10
and having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion having a single inlet at said proximal end and a single outlet at said distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion and	page 15, lines 4-9; page 15, line 24 to page 18, line 13
being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 20, line 12 to page 21, line 8
sized to fit a diameter of the aorta;	page 20, line 12 to page 21, line 8

each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer and	page 19, lines 15-19; Figs. 5, 6; page 23, lines 1-4
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	page 20, lines 4-10, Figs. 5, 6; page 22, lines 1-13; Fig. 6
joining means for intraluminally joining said distal end of said proximal prosthesis portion to said proximal end of said prosthesis portion.	Figs. 1A, 6; page 4, line 1 to page 6, line 6
Claim 55	
wherein said joining means includes a friction fit engagement between said distal end of said proximal prosthesis portion in said expanded configuration and said proximal end of said prosthesis portion in said expanded configuration.	page 4, line 1 to page 6, line 6
Claim 56	
wherein said proximal prosthesis portion has a first diameter at said proximal end and a second diameter less than said first diameter at said distal end.	page 23, line 6-15
Claim 57	
further comprising securing means projecting from said proximal end of said proximal prosthesis portion for securing said proximal prosthesis portion to the aorta.	page 19, lines 25 to page 20, line 2
Claim 58	
A modular prosthesis for repairing an aortic aneurysm in an aorta extending from a heart of a patient, comprising:	Figs. 1A, 1B, 5, 6
a prosthesis portion	page 17, line 25 to page 18, line 13; Figs. 1A, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 20, lines 4-10

having a proximal end and a distal end;	Figs. 1A, 6
a proximal prosthesis portion	Figs. 1A, 6
expandable radially from a collapsed configuration and an expanded configuration	page 20, lines 4-10
and having a proximal end and a distal end,	Figs. 1A, 6
said proximal prosthesis portion being formed separately from said prosthesis portion	page 15, lines 4-9; page 15, line 24 to page 18, line 13
and being adapted to lie in the aorta with said proximal end pointing toward the heart and	page 20, line 12 to page 21, line 8
sized to fit a diameter of the aorta;	page 20, line 12 to page 21, line 8
each of said prosthesis portion and said proximal prosthesis portion including	
a flexible layer	page 19, lines 15-19; Figs. 5, 6
and an expandable stent radially supporting said flexible layer along substantially the entire length thereof;	page 20, lines 4-10; Figs. 5, 6
at least one distal prosthesis portion	page 19, lines 1-13; page 22, lines 1-13; Figs. 1A, 1B, 6
expandable radially between a collapsed configuration and an expanded configuration and	page 20, lines 4-10; page 22, lines 1-13
having a proximal end and a distal end,	Figs. 1A, 1B, 6
said distal prosthesis portion including	
a flexible layer and	page 23, lines 1-4; Fig. 6; page 19, lines 15-23
an expandable stent radially supporting said flexible layer along substantially the entire length thereof; and	Fig. 6

connecting means for connecting said proximal end of said distal prosthesis portion to said distal end of said prosthesis portion.	page 22, lines 1-13; Figs. 1A, 1B, 6; page 19, lines 6-13; page 4, line 1 to page 6, line 6
Claim 59 wherein said connecting means includes a friction fit engagement between said proximal end of said distal prosthesis portion in said expanded configuration and said distal end of said prosthesis portion in said expanded configuration.	page 4, line 1 to page 6, line 6; page 22, lines 1-13
Claim 60 wherein said distal prosthesis portion has a length between said proximal end and said distal end of between about 4 cm and about 15 cm.	page 19, lines 5-6

The present Goicoechea application is a continuation of Serial No. 08/463,987, filed June 5, 1995, now pending, which is a division of Serial No. 08/317,763, filed October 4, 1994, now U.S. Patent No. 5,609,627, which is a continuation-in-part of Serial No. 08/312,881, filed September 27, 1994, now pending. The present application is also a continuation-in-part of Serial No. 08/312,881.

Benefit is also claimed based on EP 94400284.9, filed February 9, 1994, and EP 94401306.9, filed June 10, 1994. Copies enclosed.

Appendices E, F, and G are charts providing an element-by-element recitation of the claims of the Goicoechea application and an indication of the passages in Serial No. 08/312,881, EP 94401306.9, and EP 94400284.9, respectively, where, at the very least, the claims find support. This Goicoechea application should be accorded benefit of these prior applications in the declaration of interference. Accordingly, the effective U.S. filing date of this Goicoechea application is September 27, 1994, and the effective foreign filing date of this Goicoechea application is February 9, 1994.¹

Goicoechea et al. should also be designated as the senior party in the interference as having an effective filing date earlier than February 24, 1995, the earliest effective filing date that can be alleged by Marcade. Goicoechea et al. should be entitled to an effective filing date of February 9, 1994 based on the filing date of EP 94400284.9. If Goicoechea et al. is not accorded the filing date of EP 94400284.9 or 94401306.9, it should be entitled to an effective filing date of September 27, 1994, based upon on the filing date of U.S. Application Serial No. 08/312,881, which also predates February 24, 1995.

VI. 35 U.S.C. § 135(b) IS SATISFIED (37 C.F.R. § 1.607(a)(6))

Claims of the Goicoechea application which are the same as, or for the same or substantially the same subject matter as, claims of the Marcade patent were made within one year from the date on which the Marcade patent was granted. Specifically, the pending claims were presented in a Preliminary Amendment filed July 9, 2003, within one year from July 9,

¹ The Examiner's attention is directed to the decision of the Board of Patent Appeals and Interferences dated July 27, 2001, in Interference No. 104,192, in which the Board granted a motion (Preliminary Motion 12) requesting denial of the benefit of EP94400284.9 and EP94401306.9. (Copy Enclosed) The BPAI decision has been contested in Civil Action No. 01-CV-2015 now pending in the United States District Court for the District of Columbia.